



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*IP*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/177,392	01/04/00	HEINTZ	N V0139/7038- (

HELEN C LOCKHART  
WOLF GREENFIELD & SACKS P C  
600 ATLANTIC AVENUE  
BOSTON MA 02210

HM22/1219

EXAMINER

ZEMAN, R

ART UNIT

PAPER NUMBER

1645

*6*

DATE MAILED:

12/19/00

Please find below and/or attached an Office communication concerning this application or  
proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/477,392

Applicant(s)  
Heintz et al.

Examiner  
Robert A. Zeman

Group Art Unit  
1645



☒ Responsive to communication(s) filed on Jan 4, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-23 and 29 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-23 and 29 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1645

### **DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit **1645**.

#### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to nucleic acids, vectors and host cells expressing said vectors, classified in class 536, subclass 23.1.
- II. Claims 17-22, drawn to polypeptides, classified in class 530, subclass 350.
- III. Claim 23, drawn to agents that bind polypeptides, classified in class 530, subclass 387.1.
- IV. Claim 29, drawn to a method of determining RIP60 expression levels, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the polypeptides of Invention II can be made synthetically. Invention I also contains products that are

Art Unit: 1645

separate and distinct from the products of Invention II as they comprise completely differing biochemical and immunological entities having differing properties and uses. Invention II is drawn to polypeptides, whereas Invention I is drawn to nucleic acids, cells and vectors.

Inventions I and III are separate and distinct as they comprise completely differing biochemical and immunological entities having differing properties and uses. Invention I is drawn to polynucleotides, whereas Invention III is drawn to substances that bind polypeptides.

Inventions I and IV are separate and distinct as the polynucleotides of Invention II cannot be used in the methods of Invention IV. Additionally Inventions I and IV are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions II and III are separate and distinct as they comprise completely differing biochemical and immunological entities having differing properties and uses. Invention II is drawn to polypeptides, whereas Invention III is drawn to substances that bind polypeptides.

Inventions II and IV are separate and distinct as the polypeptides of Invention II cannot be used in the methods of Invention IV.

Inventions III and IV are separate and distinct as the substances of Invention III cannot be used in the methods of Invention IV.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1645

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991. The examiner can be reached between the hours of 7:30 am and 4:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, Donna Wortman, Primary Examiner can be reached at (703) 308-1032 or the examiner's supervisor, Lynette Smith, can be reached at (703)308-3909.

  
DONNA WORTMAN  
PRIMARY EXAMINER

Robert A. Zeman

December 15, 2000